

### **REMARKS**

This responds to the Office Action mailed on March 28, 2006, and the references cited therewith.

Claims 1, 11, 12, 13, 16, 21, and 28 are amended. Claims 1-32 remain pending in this application.

#### **§103 Rejection of the Claims**

Claims 1-6, 9, 10-17, 19-24, 28, 29, 31 and 32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Williams et al. (U.S. Patent No. 5,597,995) in view of Schlamp (U.S. Patent No. 5,385,265) and further in view of Ahlin et al. (U.S. Patent No. 6,219,587 B1).

#### **Claims 1-6, 9, and 10-12**

Claim 1 has been amended to better describe the subject matter recited in the claim. Applicant believes claim 1 is not obvious in view of the cited references since, even if combined, the combination does not include each limitation recited in the claim. For instance, Applicant cannot find in the combination: a dispensing mechanism to hold each of the one or more filled prescription containers in a first location which is inaccessible to a user while an order is being filled, the dispensing mechanism controlled to release all of the one or more filled prescription containers to a pick-up area accessible to the user only after the order has been entirely filled.

Claims 2-6, 9, and 10-12 include each limitation of their parent claim and are therefore also not obvious in view of the cited references. Reconsideration and allowance is respectfully requested.

#### **Claims 13-15**

Claim 13 has been amended to better describe the subject matter recited in the claim. Applicant believes claim 13 is not obvious in view of the cited references since, even if combined, the combination does not include each limitation recited in the claim. For instance, Applicant cannot find in the combination: the dispensing machine holding each of the one or more filled prescription containers in a first location which is inaccessible to a user while the customer request is being filled, the dispensing machine releasing all of the one or more filled

prescription containers to a pick-up area accessible to the user only after the customer request has been entirely filled.

Claims 14-15 include each limitation of their parent claim and are therefore also not obvious in view of the cited references. Reconsideration and allowance is respectfully requested.

Claims 16-17 and 19-20

Claim 16 has been amended to better describe the subject matter recited in the claim. Applicant believes claim 16 is not obvious in view of the cited references since, even if combined, the combination does not include each limitation recited in the claim. For instance, Applicant cannot find in the combination: a dispensing mechanism to hold each of the one or more filled prescription containers in a first location which is inaccessible to a user while an order is being filled, the dispensing mechanism controlled to release all of the one or more filled prescription containers to a pick-up area accessible to the user only after the order has been entirely filled.

Claims 17 and 19-20 include each limitation of their parent claim and are therefore also not obvious in view of the cited references. Reconsideration and allowance is respectfully requested.

Claims 21-24

Claim 21 has been amended to better describe the subject matter recited in the claim. Applicant believes claim 21 is not obvious in view of the cited references since, even if combined, the combination does not include each limitation recited in the claim. For instance, Applicant cannot find in the combination: a dispensing mechanism to hold each of the filled prescription containers in a first location which is inaccessible to a user while an order is being filled, the dispensing mechanism controlled to release all of the filled prescription containers to a pick-up area accessible to the user only after the order has been entirely filled.

Claims 22-24 include each limitation of their parent claim and are therefore also not obvious in view of the cited references. Reconsideration and allowance is respectfully requested.

Claims 28-29

Claim 28 has been amended to better describe the subject matter recited in the claim. Applicant believes claim 28 is not obvious in view of the cited references since, even if combined, the combination does not include each limitation recited in the claim. For instance, Applicant cannot find in the combination: the dispensing machine holding each of the one or more filled prescription containers in a first location which is inaccessible to a user while the customer request is being filled, the dispensing machine releasing all of the one or more filled prescription containers to a pick-up area accessible to the user only after the customer request has been entirely filled.

Claim 29 includes each limitation of its parent claim and is therefore also not obvious in view of the cited references. Reconsideration and allowance is respectfully requested.

Claim 31

Applicant traverses the rejection of claim 31. Applicant believes claim 31 is not obvious in view of the cited references since, even if combined, the combination does not include each limitation recited in the claim. For instance, Applicant cannot find in the combination: wherein the unlabeled prescription medication is labeled with patient specific information by the automatic dispensing machine before being dispensed. Reconsideration and allowance is respectfully requested.

Claim 32

Applicant traverses the rejection of claim 32. Applicant believes claim 32 is not obvious in view of the cited references since, even if combined, the combination does not include each limitation recited in the claim. For instance, Applicant cannot find in the combination: the second machine labeling and dispensing prescription medication to a customer in response to a customer request. Reconsideration and allowance is respectfully requested.

Claims 7, 8, 18, 25 and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Williams et al. (U.S. Patent No. 5,597,995) in view of Schlamp (U.S. Patent No. 5,385,265) and further in view of Ahlin et al. (U.S. Patent No. 6,219,587 B1).

Claims 7, 8, 18, 25 and 26 include each limitation of their respective parent claims and are not obvious in view of the cited references since the secondary reference does not overcome the deficiencies of the primary references, as discussed above. Reconsideration and allowance is respectfully requested.

Claims 27 and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Williams et al. (U.S. Patent No. 5,597,995) in view of Schlamp (U.S. Patent No. 5,385,265) and further in view of Wallace et al. (U.S. Patent No. 6,564,121 B1).

Claims 27 and 30 include each limitation of their respective parent claims and are not obvious in view of the cited references since the secondary reference does not overcome the deficiencies of the primary references, as discussed above. Reconsideration and allowance is respectfully requested.

#### Double Patenting Rejection

Claims 1-32 were rejected under a non-statutory obviousness-type double patenting rejection, specifically over claims 1-15 of U.S. Patent No. 6,892,941 B2. A terminal disclaimer is enclosed herewith to obviate the double patenting rejection.

Claims 1-32 were provisionally rejected on the ground of nonstatutory obviousness-type double-patenting as being unpatentable over claims 1-16 of copending Application No. 10/784,507. A terminal disclaimer is enclosed herewith to obviate the double patenting rejection.

**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 359-3267 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

KEN ROSENBLUM

By his Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.  
P.O. Box 2938  
Minneapolis, MN 55402  
(612) 359-3267

Date 7-28-06


By Peter C. Maki  
Peter C. Maki  
Reg. No. 42,832

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 28<sup>th</sup> day of July, 2006..

PATRICIA A. HULTMAN

---

Name



Signature